

REMARKS

Claims 1-12 remain pending in the application.

Claims 1 and 7 over Brown in view of Latter

In the Office Action, claims 1 and 7 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 5,631,950 to Brown ("Brown") in view of U.S. Patent No. 6,178,232 to Latter et al. ("Latter"). The Applicants respectfully traverse the rejection.

Claim 1 recites introducing over a telephone line a **digitized version of an audio message** relating to a call from a calling telephone to a called telephone while a telephone line of the called telephone remains in an **on-hook state**. Claim 7 recites introducing over a telephone line a **digitized version of an audio message** relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an **on-hook state**; and (2) during a detected **silent interval**.

The Examiner alleges Brown discloses a method for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook condition (Office Action, page 2). The Examiner contradicts the Examiner's allegation from page 2 and acknowledges that Brown discloses a data message from a calling party but fails to disclose an audio message between a calling telephone apparatus and a called telephone apparatus (Office Action, page 3). Nevertheless, the Examiner relies on Latter to allegedly make up for the deficiencies in Brown. The Applicants respectfully disagree.

The Examiner acknowledgment on page 3 is supported by Brown. Brown repeats throughout the specification that a data message is transmitted from a calling part to a called party during silent intervals of ringing (Brown, col. 4, lines 16-18).

The Examiner alleges that Latter discloses an audio message between a calling telephone apparatus and a called telephone apparatus (Office Action, page 3). Although Latter discloses use of an audio message, the audio message from the calling telephone apparatus and a called telephone apparatus

is transmitted when the called party answers the telephone call, i.e., the called telephone goes off-hook (Fig. 7, step 530; col. 5, lines 36-40). Thus, Latter fails to disclose or suggest sending any information to a called telephone while it remains in an on-hook state, much less a digitized version of an audio message to a called telephone while in an on-hook state, as recited in claims 1 and 7.

Thus, even if the combination of Brown and Latter were obvious (which it is not), Brown modified by the disclosure of Latter would still not result in the features claimed. The theoretical apparatus resulting from Brown modified by Latter would result in a data message being sent to a called telephone while the called telephone is in an on-hook state (Brown) and when a called telephone goes off-hook sending an audio message (Latter).

Moreover, “Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). There is no suggestion to modify Brown to send a digitized version of an audio message instead of the data message disclosed by Brown. Brown sends telephone data information to a called party such as a telephone number, similarly as Called ID information is sent to a called party. Such information is displayed for a called party. There is no suggestion in either Brown nor Latter of a need to send a digitized version of an audio message since Brown is only concerned with displaying a telephone number.

Neither Brown nor Latter, either alone or in combination, disclose, teach or suggest introducing a digitized version of an audio message to a called telephone while the called telephone remains in an on-hook state, much less during silent interval, as respectively recited by claims 1 and 7.

For at least all the above reasons, claims 1 and 7 are patentable over the cited art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 2, 3, 8 and 9 over Brown in view of Latter and Guercio

In the Office Action, claims 2, 3, 8 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Brown in view of Latter, and further in view of U.S. Patent No. 6,373,925 to Guercio (“Guercio”). The Applicants respectfully traverse the rejection.

Claims 2, 3, 8 and 9 are dependent on claims 1 and 7 respectively, and area allowable for at least the same reasons as claims 1 and 7.

Claims 2 and 3 recite introducing over a telephone line a **digitized version of an audio message** relating to a call from a calling telephone to a called telephone while a telephone line of the called telephone remains in an **on-hook state**. Claims 8 and 9 recite introducing over a telephone line a **digitized version of an audio message** relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an **on-hook state**; and (2) during a detected **silent interval**.

As discussed above, neither Brown nor Latter, either alone or in combination, disclose, teach or suggest introducing a **digitized version of an audio message** to a called telephone while the called telephone remains in an **on-hook state**, much less during a detected **silent interval**, as respectively recited by claims 2, 3, 8 and 9.

The Office Action relies on Guercio to allegedly make up for the deficiencies in Brown in view of Latter. The Applicants respectfully disagree.

Guercio is relied on to disclose a signal identifying a calling party during a silent interval provided to a called telephone apparatus, whereby the called telephone apparatus is provided with Caller ID information in addition to an audio message (Office Action, page 6). The Applicants respectfully disagree.

Guercio discloses sending **only Caller ID information** to a called telephone apparatus. The Caller ID information is used to **look up** a voice message associated with the Caller ID information **stored in a table on the called telephone apparatus**. Thus, **NO audio message** passes from a calling telephone to a called telephone while the called telephone is in an **on-hook state**, only **Caller ID data**. Guercio fails to disclose or suggest any type of **audio message** introduced to a called telephone while the called telephone remains in an **on-hook state**, as recited by claims 2, 3, 8 and 9.

Thus, even if the combination of Brown, Latter and Guercio were obvious (which it is not), Brown modified by the disclosure of Latter and Guercio would still not result in the features claimed. The theoretical apparatus resulting from Brown modified by Latter and Guercio would result in a data message being sent to a called telephone while the called telephone is in an on-hook state (Brown and Guercio) and when a called telephone goes off-hook sending an audio message (Latter).

Neither Brown, Latter nor Guercio, either alone or in combination, disclose, teach or suggest introducing a digitized version of an audio message to a called telephone while the called telephone remains in an on-hook state, much less during a detected silent interval, as respectively recited by claims 2, 3, 8 and 9.

For at least all the above reasons, claims 2, 3, 8 and 9 are patentable over the cited art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 4 and 10 over Brown in view of Hamrick

In the Office Action, claims 2, 3, 8 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Brown in view of U.S. Patent No. 6,466,653 to Hamrick et al. ("Hamrick"). The Applicants respectfully traverse the rejection.

Claim 4 recites receiving over a telephone line a digitized version of an audio message relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an on-hook state; and (2) during a silent interval following a ringing signal appearing at the called telephone. Claim 10 recites receiving over a telephone line a digitized version of an audio message relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an on-hook state; and (2) during a detected silent interval.

The Office Action acknowledged that Brown fails to disclose an audio message between a calling telephone apparatus and a called telephone apparatus (Office Action, page 3) and converting a digitized version of an audio

message to an acoustic version thereof and introducing the acoustic version to a speaker to produce an audio version of the audio message (Office Action, page 8). The Office Action relies on Hamrick to allegedly make up for the deficiencies in Brown. The Applicants respectfully disagree.

Hamrick simply discloses a system and method of allowing a called telephone to hear a text-to-speech converted version of Caller ID (Abstract). The **only** information received by the called party is **Caller ID data information** while in an **on-hook state**. Hamrick fails to disclose receiving a **digitized version of an audio message** while in an **on-hook state**, much less during a **silent interval**, as recited by claims 4 and 10.

Thus, even if the combination of Brown and Hamrick were obvious (which it is not), Brown modified by the disclosure of Hamrick would still not result in the features claimed. The theoretical apparatus resulting from Brown modified by Hamrick would result in a **data message** being received by a called telephone while the called telephone is in an **on-hook state** (Brown and Hamrick) and (Hamrick).

Neither Brown nor Hamrick, either alone or in combination, disclose, teach or suggest receiving a **digitized version of an audio message** to a called telephone while the called telephone remains in an **on-hook state**, much less during a detected **silent interval**, as respectively recited by claims 4 and 10.

For at least all the above reasons, claims 4 and 10 are patentable over the cited art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 5, 6, 11 and 12 over Brown in view of Hamrick and Guercio

In the Office Action, claims 5, 6, 11 and 12 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Brown in view of Hamrick, and further in view of Guercio. The Applicants respectfully traverse the rejection.

Claims 5, 6, 11 and 12 are dependent on claims 4 and 10 respectively, and are allowable for at least the same reasons as claims 4 and 10.

Claims 5 and 6 recite receiving over a telephone line a digitized version of an audio message relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an on-hook state; and (2) during a silent interval following a ringing signal appearing at the called telephone. Claims 11 and 12 recite receiving over a telephone line a digitized version of an audio message relating to a call from a calling telephone to a called telephone: (1) while a telephone line of the called telephone remains in an on-hook state; and (2) during a detected silent interval.

As discussed above, neither Brown nor Hamrick, either alone or in combination, disclose, teach or suggest receiving a digitized version of an audio message to a called telephone while the called telephone remains in an on-hook state, much less during a detected silent interval, as respectively recited by claims 5, 6, 11 and 12.

The Office Action relies on Guercio to allegedly make up for the deficiencies in Brown in view of Hamrick. The Applicants respectfully disagree.

As discussed above, Guercio discloses only Caller ID information received by a called telephone apparatus. The Caller ID information is used to look up a voice message associated with the Caller ID information stored in a table on the called telephone apparatus. Thus, NO audio message passes from a calling telephone to a called telephone while the called telephone is in an on-hook state, only Caller ID data.

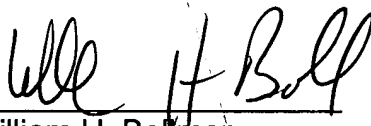
Neither Brown, Hamrick nor Guercio, either alone or in combination, disclose, teach or suggest receiving a digitized version of an audio message to a called telephone while the called telephone remains in an on-hook state, much less during a detected silent interval, as respectively recited by claims 5, 6, 11 and 12.

For at least all the above reasons, claims 5, 6, 11 and 12 are patentable over the cited art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



William H. Bollman
Reg. No. 36,457

Manelli Denison & Selter PLLC
2000 M Street, NW
Suite 700
Washington, DC 20036-3307
TEL: (202) 261-1020
FAX: (202) 887-0336

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